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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/838,620	04/19/2001	David B. Orchard	CA920000010US1	3584

7590 06/04/2004

IBM Corporation
Intellectual Property Law, Dept. 917
3605 Highway 52 North
Rochester, MN 55901

EXAMINER

RUTTEN, JAMES D

ART UNIT	PAPER NUMBER
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2122

DATE MAILED: 06/04/2004

11

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/838,620

Applicant(s)

ORCHARD ET AL.

Examiner

J. Derek Rutten

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 April 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Applicants' amendment dated March 22 2004, responding to the December 17 2003 Office Action provided in the rejection of claims 1-36, wherein claims 4, 5, 9, 12, 14, 17, 19, 20, 24, 25, 29, and 32 have been amended. Claims 1-36 remain pending in the application and have been fully considered by the examiner.

Response to Arguments

2. Applicant's arguments, see page 10 paragraph 2, filed March 17 2004, with respect to claims 4, 9, 12, 14, 20, 24, 29, 32, and 34 have been fully considered but they are not persuasive. Applicant has argued that the trademark "Java" is well known and is no less definite than a claim that recites C++. However, the trademark JAVA identifies the source of the products and not the products themselves. In contrast, for example, C++ is a name used in trade to identify a particular nonproprietary programming language conforming to an accepted standard. Products and services incorporating the name C++ are produced by numerous sources. Further, the technologies identified using the trademark JAVA are continuously evolving. An example of this evolution can be found in "JSR 14: Add Generic Types To The Java™ Programming Language", which describes a proposed amendment to the JAVA Language Specification submitted by Sun Microsystems, Inc., in 1999 and pending approval by the JAVA COMMUNITY PROCESS Program. In view of the statements presented above, it is asserted that the trademark JAVA has no fixed definite technical meaning. Accordingly, a rejection under 35 U.S.C. 112, second paragraph, based on the use of the trademark JAVA as a limitation in a claim, is proper.

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3. Applicant's arguments, see page 10 paragraph 3, filed March 17 2004, with respect to claims 9, 10, 12, 29, 30, and 32, have been fully considered and are persuasive. The trademark XML would not be confused by those skilled in the art with the markup language used in the claims. The rejection of claims has been withdrawn.

4. Applicant's arguments, see page 11 paragraph 1, filed March 17 2004, with respect to the rejections of claims 1-36 under 35 U.S.C. 102 and 103, have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, new grounds of rejection is made in view of "XML for the absolute beginner" by Johnson in view of U.S. Patent 6,125,391 to Meltzer et al.

Drawings

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the transformation language of claims 6 and 26, and the XSL of claims 7, 16, 27, and 36 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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7. Claims 1, 4, 9, 12-14, 17, 20, 22, 24, 29, and 32-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claims 4, 9, 12, 14, 20, 24, 29, 32, and 34 contain the trademark/trade name JAVA.

Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe an interpreted object-oriented programming environment and, accordingly, the identification/description is indefinite.

9. Claims 1, 9, 13, 17, 22, 29, and 33 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: Method steps a) and b) as claimed in claims 1, 9, 13, and 17, and steps i) and ii) as claimed in claims 22, 29, and 33, are not connected in any way to step c) or iii), respectively. For the purpose of further examination, the generation of the class of step c)/iii) will be interpreted as being necessarily dependent upon the results of prior steps a)/i) and b)/ii).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over “XML for the absolute beginner” by Johnson (hereinafter referred to as “Johnson”), in view of U.S. Patent 6,125,391 to Meltzer et al. (hereinafter referred to as “Meltzer”).

As per claim 1, Johnson discloses:

A method of data access code generation, comprising:

*a) describing a data object in a data object description document (page 14 under the heading “Formatting XML as HTML: An example”: “An XSL file is a series of rules, called *templates*, that are applied to an input **XML file**.”);*

*b) applying at least one code generation template to said data object description document (page 14 as cited above: “**XSL file**”);*

*c) generating <code> (page 14: “Each time a template matches something in the input, the template **produces a new structure** in the output...”)*

Johnson does not expressly disclose generating a *data access class*.

However, in an analogous environment, Meltzer teaches the generation of a data access class from a data object description document (column 26 lines 25-26: “In this example,

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the XML logic structures are **translated into JAVA objects** which carry the data of the XML element as well as methods associated with the data such as get and set functions.” Java objects refers to an object-oriented programming language instance of a class.).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Meltzer’s teaching of class generation with Johnson’s code generator. One of ordinary skill would have been motivated to generate classes that are compatible with an existing system while providing a standard representation of data description objects.

As per claim 2, the above rejection of claim 1 is incorporated. Johnson further discloses: *wherein said data object description document conforms to a data object document type definition* (page 9 under the heading “Make up a markup”: “document type definition”).

As per claim 3, the above rejection of claim 1 is incorporated. Johnson further discloses: *wherein steps b) and c) are performed by a data access code generator routine* (page 16 2nd paragraph: “XSL processor”).

As per claim 4-7, the above rejection of claim 1 is incorporated. All further limitations have been addressed in that claim.

As per claim 8, the above rejection of claim 3 is incorporated. Johnson further discloses: *wherein said data access code generator takes said data object description document and said at least one code generation template as inputs and outputs said at least one data access class* (page 14 paragraph 2 describes an XSL file and an XML file as inputs to an XSL processor. The processor then generates an output based on the inputs.). All further limitations have been addressed in the above rejection of claim 1.

As per claims 9, 10, 11, and 12, all limitations have been addressed in the above rejections of claims 1, 2, 3, and 8, respectively.

As per claim 13, Johnson discloses an object-oriented programming environment (page 17 paragraph 3: "With the DOM, HTML and XML documents can be manipulated as **objects**, instead of just as streams of text. In fact, from the DOM point of view, the document is the object tree, and the XML, HTML, or what have you is simply a persistent representation of that tree."). All further limitations have been addressed in the above rejection of claim 1.

As per claim 14, the above rejection of claim 13 is incorporated. Johnson further discloses operation in the JAVA object-oriented programming environment (page 18: "XML and Java").

As per claims 15 and 16, the above rejection of claim 13 is incorporated. All further limitations have been addressed in the above rejections of claims 2 and 7, respectively.

As per claim 17, Johnson disclose an apparatus (page 21 paragraph 3). All further limitations have been addressed in the above rejection of claim 1.

As per claim 18, the above rejection of claim 17 is incorporated. All further limitations have been addressed in the above rejection of claim 2.

As per claim 19, the above rejection of claim 17 is incorporated. All further limitations have been addressed in the above rejections of claims 1 and 8.

As per claims 20, and 21 the above rejection of claim 17 is incorporated. All further limitations have been addressed in the above rejections of claims 4 and 5, respectively.

As per claim 22, Johnson discloses:

A program product (page 21 paragraph 2: "Epicentric uses Java and XML in its **turnkey systems** to allow creation of custom portal sites").

Johnson does not expressly disclose a memory.

However, Meltzer teaches the use of a memory to store a code generator (column 87 lines 48 – column 90 line 25).

All further limitations have been addressed in the above rejection of claim 1.

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Meltzer's memory in Johnson's code generator. One of ordinary skill would have been motivated to use memory to hold program code which would allow a processor to execute the code.

As per claims 23-28, the above rejection of claim 22 is incorporated. All further limitations have been addressed in the above rejections of claims 2, and 4-8, respectively.

As per claim 29, all limitations have been addressed in the above rejections of claims 1 and 22.

As per claims 30-32, the above rejection of claim 29 is incorporated. All further limitations have been addressed in the above rejections of claims 2, 3, and 8, respectively.

As per claim 33, all limitations have been addressed in the above rejections of claims 1, and 22.

As per claims 34-36, the above rejection of claim 33 is incorporated. All further limitations have been addressed in the above rejections of claims 14, 2, and 7, respectively.

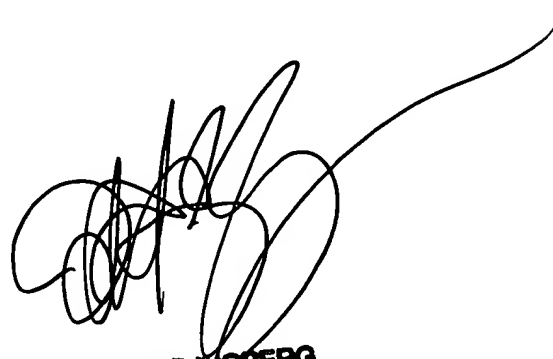
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Derek Rutten whose telephone number is (703) 605-5233. The examiner can normally be reached on M-F 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam can be reached on (703) 305-4552. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jdr



**TODD HOBERG
PRIMARY EXAMINER**